

Application No. 10/663,044
Amendment dated February 28, 2006
Reply to Office Action of January 4, 2006

REMARKS:**Status Of Claims**

Claims 1-29 were previously pending. The Examiner apparently withdrew claims 9-12 and 15-29. Claim 1 has been amended. Claims 30-39 have been added. Thus, claims 1-8, 13, 14, and 30-39 are currently pending in the application with claims 1 and 31 being independent.

Office Action

In the December 12, 2005 Interview Summary, the Examiner accurately captured the conversation. Specifically, because Applicant does not believe the Examiner's assertions provide a basis for distinction, Applicant believes the Examiner has failed to show how Group I is distinct with respect to Group II. More specifically, claims in both Group I and Group II have limitations relating the navigational device to the carrying case, and therefore it is difficult to see how the Examiner's assertion that "the apparatus as claimed does not required the navigational device to be stored in a carrying case to work" provides a basis for distinction.

Applicant elected Group I and Species I, with traverse. However, precisely because the Examiner has failed to show a basis for distinction, Applicant believes all claims read on the elected invention and species.

In the January 4, 2006 Office Action, the Examiner incorrectly stated that "[t]he traversal is on the ground(s) that 'Applicant believes all claims read on the elected

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invention and species". Not surprisingly, the Examiner did not find this persuasive. However, the grounds for the traversal is, in fact, that the Examiner has failed to show a basis for distinction. The most recent action fails to cure this defect. Therefore, because the Examiner has failed to show a basis for distinction, Applicant believes all claims read on the elected invention and species. Thus, Applicant respectfully requests reversal of this requirement, or that the Examiner provide the requisite basis for distinction.

In the January 4, 2006 Office Action, the Examiner rejected claims 1-8 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Ross et al., U.S. Patent No. 5,859,628, in view of Lewis, GB 2,405,049, or Yaski et al., U.S. Patent Application No. 2001/0040109:

The Examiner also rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Ross in view of Lewis or Yaski in further view of Ockerse et al., U.S. Patent No. 6,928,366. Applicant respectfully submits that the currently pending claims distinguish the present invention from Ross, Lewis, Yaski, Ockerse, and the other prior art references of record, taken alone or in combination with each other.

Specifically, claim 1 recites "a carrying case sized and configured to removably fit substantially within a tray of the vehicle and configured to substantially enclose the navigational device, wherein the case is configured to substantially conform to the tray".

Claim 2 further recites "wherein the tray is originally installed in the vehicle during manufacture of the vehicle". Finally, claim 3 recites "wherein the tray is positioned on a dashboard of the vehicle". This configuration can be seen, for example, in figures 19 and 20.

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In contrast, neither Ross, Lewis, Yaski, nor Ockerse disclose "a carrying case sized and configured to removably fit substantially within a tray of the vehicle and configured to substantially enclose the navigational device, wherein the case is configured to substantially conform to the tray", as claimed in claim 1, much less the limitations of claims 2 or 3. Simply put, the Examiner has failed to cite prior art references that teach each claim limitation, or even provide the requisite suggestion or motivation to combine such references, and therefore has failed to properly establish a *prima facie* case of obviousness.

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP § 2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed.

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Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

Specifically, the Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) ***the prior art reference (or combination of references) must teach or suggest all the claim limitations.*** MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 1442 (Fed. Cir. 1991). Thus, measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art

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suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Additionally, "the mere possibility that one [element] could be modified or replaced ... does not make the [claim] obvious 'unless the prior art suggested the desirability of [such a] modification' or replacement". *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1995) (citing *In re Gordon*).

In the present case, the Examiner has failed to cite a prior art reference that discloses, suggests, or makes obvious "a carrying case sized and configured to removably fit substantially within a tray of the vehicle and configured to substantially enclose the navigational device, wherein the case is configured to substantially conform to the tray", and claimed in claim 1, much less "wherein the tray is originally installed in the vehicle during manufacture of the vehicle", as claimed in claim 2. Specifically, neither Ross, Lewis, Yaski, nor Ockerse even suggest a case being configured to substantially conform to a tray of the vehicle, much less an OEM tray "originally installed in the vehicle during manufacture of the vehicle". Specifically, while Ross' cradle 104 is designed to conform to his PDA 102, there is absolutely no teaching or suggestion that Ross' cradle 104 conform to any portion of his vehicle. Neither of Lewis' or Yaski's disclosures even suggest that their inventions could be made to conform to any portion of a vehicle. Actually, quite the opposite. For example, Lewis' invention is designed to be worn on a user's head, and therefore any modification to conform to a vehicle tray, would render Lewis unsuitable for its intended purpose. Similarly, Yaski's invention is designed to be worn on a user's belt, and therefore

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any modification to conform to a vehicle tray, would render Yaski unsuitable for its intended purpose.

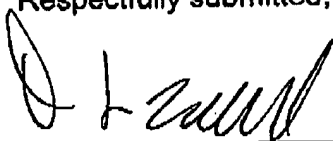
Furthermore, the Examiner cites no suggestion or motivation, found in the prior art, for combining the references. Rather, the only suggestion is found in the present application itself, thereby rendering the Examiner's combination impermissible hindsight reconstruction. In fact, as discussed above, the Examiner's proposed modifications would render many of the references unsuitable for their intended purposes, and therefore the Examiner's proposed combination is improper. As a result, the Examiner has failed to properly establish a *prima facie* case of obviousness, and therefore the present obviousness rejections simply cannot be sustained.

Claims 30-39 have been added. The remaining claims all depend directly or indirectly on claim 1, and are therefore also allowable.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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